

### REMARKS

Claims 7-10, 19-25, 34-36, 38-50 and 52-61 are in this Application and presented for reconsideration. Applicants have taken notice that the two cited references, the JP03-003030 to Tajima (the "Tajima '030" reference, hereinafter) and the U.S. Pat. No. 5,663,811 to Shimizu (the "Shimizu '811" reference, hereinafter) were either submitted by the Applicants or used in a previous Office Action rejection. Accordingly, Applicants have not made any changes to the claims. Instead, Applicants provide herewith reasons why the claims properly read over the prior art of record stated in the Office Action by pointing out the differences between the mainly independent claims and the references or the combination thereof.

### Allowable Subject Matter

The Office withdraw a previous indicated allowability of claims 7-10, 19-25, 34-36, 38-50, and 52-61 and reopened the prosecution on the merits of this application. The indicated allowability of the above claims was withdrawn in view of the Tajima '030 reference.

The Office states that the present application does not have novelty or inventive step on the basis of the Tajima '030 reference and the Shimizu '811 reference. Especially, the examiner states that:

- (a) claims 7 to 9 have no novelty on the basis of the Tajima '030 reference;

- (b) claim 10 has no inventive step on the basis of the Tajima '030 reference and the Shimizu '811 reference;
- (c) claims 19 to 25, 34 to 36 and 46 to 50 have no inventive step on the basis of the Tajima '030 reference and the Shimizu '811 reference;
- (d) claims 38 to 40, 42 to 45 and 52 to 61 have no inventive step on the basis of the Shimizu '811 reference; and
- (e) claim 41 has no inventive step on the basis of the Tajima '030 reference and the Shimizu '811 reference.

#### Claim Rejections - 35 USC § 102

Claims 7-9 have been rejected under 35 U.S.C. 102(b) as being anticipated by the Tajima '030 reference. This is based on the proposition that the Tajima '030 reference discloses all combination of features present in claims 7-9.

Applicants respectfully disagree. The prior art as a whole including the Tajima '030 reference neither teaches nor suggests the present invention as claimed. The Tajima '030 reference discloses a second sheet transporting path (5). However, the second sheet transporting path (5) is not defined "by a scanner apparatus and a base apparatus" "when the scanner is mounted" on the base apparatus. Because the path (5) is also shown in FIG. 1, in which the scanner 2 is taken away.

On the other hand, the present invention of claim 7 has the second sheet

transporting path which is defined by “a scanner apparatus and a base apparatus” “when the scanner is mounted” on the base apparatus.

Thus, the independent claim 7 has novelty even when the Tajima ‘030 reference is considered.

Further, the dependent claims 8 and 9 depended from claim 7 also has novelty even when the Tajima ‘030 reference is considered.

#### Claim Rejections - 35 USC § 103

Claim 10 has been rejected under 35 U.S.C. 103(a) as being unpatentable over the Tajima ‘030 reference as applied to claim 7 above, and further in view of the Shimizu ‘663 reference. The Office admits that the Tajima ‘030 reference fails to disclose a groove to receive the protecting member where the scanner apparatus is mounted on the base apparatus is provided in the surface of the base apparatus facing toward the protecting member, but takes the position that it is a matter well known in the art at the time the invention was made to have a groove to better hold the hand scanner mounted on the base apparatus in the Tajima ‘030 reference.

Applicants respectfully disagree. First, claim 10 has the same difference with the references as shown in the description of claim 7.

In addition to this, both of the Tajima ‘030 reference and the Shimizu ‘811 reference do not have any groove which receives a protecting member, which is for protecting a pick roller. Because the groove in FIG. 3 referred by the examiner also appears

in FIG. 2, so the groove in FIG. 3 is not the groove which receives the protecting member.

On the other hand, as shown in the description of claim 7, the present invention of claim 10 has the second sheet transporting path which is defined by “a scanner apparatus and a base apparatus” “when the scanner is mounted” on the base apparatus.

And, the present invention of claim 10 has the groove which receives a protecting member, which is for protecting a pick roller.

Thus, the dependent claim 10 has inventive step even when the Tajima ‘030 reference and the Shimizu ‘811 reference are considered. The Shimizu ‘811 reference also clearly fails to teach and fails to suggest the combination of the invention. Absent a teaching or suggestion of the important feature of the invention, the combined references clearly do not direct the person of ordinary skill in the art toward the combination as claimed.

Claims 19-25, 34-36, 46-50 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the Tajima ‘030 reference in view of the Shimizu ‘811 reference. The Office admits that the Tajima ‘030 reference fails to disclose an engaging portion and a scanner mounting portion wherein either of them is a pivotal shaft for allowing the scanner apparatus to rotate frontward while the other is in the form of a holding member for holding the pivotal shaft. However, the Office takes a stance that it is a matter well known in the art at the time the invention was made to have a pivotal shaft in the Tajima ‘030 reference to better hold the hand scanner mounted on the base apparatus since a pivotal shaft for allowing any device to rotate frontward while a mounting portion is in the form of a

holding member for holding the pivotal shaft has been known. In addition, the Office states that it is a matter of design choice to have an engaging portion to engage any device on a mounting portion. According to the Office Action, the Shimizu '811 reference supports the well known prior art by teaching a hand-held scanner mounted on a base apparatus having an engaging portion to allow the scanner apparatus to rotate frontward while the other is in the form of a holding member for holding the pivotal shaft receive and hold the hand-held scanner.

Thus, the Office takes the position that it would have been obvious to one skilled in the art at the time the invention was made as a matter of well known in the art and a matter of design choice, supported by the Shimizu '811 reference to use a pivotal shift for allowing a scanning apparatus to rotate frontward while the mounting portion is in the form of a holding member for holding the pivotal shaft since the Tajima '030 reference discloses that the scanner part 2 is attachable/detachable fitted on the recessed part 3 while does not limit any supporting mechanism for holding the scanning part 2.

Applicants respectfully disagree. The Tajima '030 reference and the Shimizu '811 reference disclose a scanner mounting portion and an engaging portion. However, both of the Tajima '030 reference and the Shimizu '811 reference do not use a pivotal shaft. That is, the examiner admits that the Shimizu '811 reference discloses the pivotal shaft and a holding member. However, the Shimizu '811 reference only discloses a scanner detaching button 100b, and only discloses that a hand scanner 200 is detached from an apparatus body 100 by pressing the scanner detaching button 100b. Accordingly, both of the Tajima '030

reference and the Shimizu '811 reference do not suggest that the hand scanner 200 "rotates" "frontward" by the "pivotal shaft."

On the other hand, the present invention of claim 19 has the pivotal shaft to rotate the scanner frontward, so that the scanner rotates frontward by the pivotal shaft.

Thus, the independent claim 19 has inventive step even when the Tajima '030 reference and the Shimizu '811 reference are considered.

Further, the dependent claims 20 – 23 depended from claim 19 also have the inventive step even when the Tajima '030 reference and the Shimizu '811 reference are considered.

Applicants also note that there must be some suggestion or teaching in the prior art as a whole which would lead the person of ordinary skill in the art to provide the combination as claimed. As the prior art as a whole fails to direct the person of ordinary skill in the art toward the claimed combination, the invention should be considered not anticipated, non-obvious and thus patentable.

Concerning claims 20, 25, the Office takes the position that the Tajima '030 reference further discloses that the scanner apparatus is so implemented as to be capable of operating as a hand scanner in a case where the scanner apparatus is detached from the base unit.

Concerning claims 21, 22, 23, and 48-50, the Office admits that the Tajima '030 reference does not disclose a lock member locking the scanner apparatus in a stated mounted on the base unit, a stopper preventing the scanner apparatus for swinging

excessively frontward of the apparatus in case the scanner is attached to or detached from the base unit, and a deviation preventing the scanner apparatus from displacing upwardly in a case where the scanner is mounted on the base unit. However, the Patent Office reasons that it was a matter of well known in the art and a matter of design choice to have a lock member locking the scanner apparatus since a lock member and a stopper are well-known to lock any device on a mounting base unit and to stop a device from swinging excessively frontward. According to the Office Action, the Shimizu '811 reference supports the well known prior art by teaching a hand-held scanner mounted on a base apparatus having an engaging portion to allow the scanner apparatus to rotate frontward while the other is in the form of a holding member or a stopper for holding or stopping the scanner. Thus, the Patent Office concludes that it would have been obvious to one skilled in the art at the time the invention was made as a matter of well known in the art and a matter of design choice to use a lock member to lock the scanner apparatus is a stated mounted on the base unit and a stopper for preventing the scanner apparatus for swinging excessively frontward of the apparatus in case the scanner is attached to or detached from the base unit since the Tajima '030 reference discloses that the scanner part 2 is attachable/detachable fitted on the recessed part 3 while does not limit any supporting mechanism for holding the scanning part 2.

First, as shown in the above description of claim 7, the sheet transporting path (5) is not defined "by the scanner apparatus and the base apparatus" "when the scanner is mounted" in the Tajima '030 reference, and also in the Shimizu '811 reference.

In addition to this, both of the Tajima '030 reference and the Shimizu '811 reference do not disclose that the sheet transporting path (5) is opened by the rotation of the scanner apparatus.

On the other hand, as shown in the description of claim 7, the present invention of claim 46 has the second sheet transporting path which is defined "by a scanner apparatus and a base apparatus" "when the scanner is mounted" on the base apparatus. And, the present invention of claim 46 has the sheet transporting path (5) which is opened by the rotation of the scanner apparatus. Thus, the independent claim 46 has inventive step even when the Tajima '030 reference and the Shimizu '811 reference are considered.

Further, the dependent claims 47 – 49 and 61 depended from claim 46 also have the inventive step even when the Tajima '030 reference and the Shimizu '811 reference are considered.

Concerning claim 24, the Patent Office takes the view that the Tajima '030 reference in view of the Shimizu '811 reference discloses the apparatus discussed in claim 19 above and further discloses a sheet guide provided on the scanner apparatus and a sheet guide provided on the base unit which are faced each other, and offset member is provided for at least one of the said two sheets guides for stepwise limiting moving of a sheet toward the sheet withdrawing port.

The Office admits that the Tajima '030 reference does not disclose that the space between two sheet guides becomes gradually narrower toward a sheet withdrawal port. However, the Office reasons that it is a matter of design choice to have any two sheets



guide path parallel or not. Further, the Office states that because the Shimizu '811 reference supports the well-known design choice of 2 sheets guide paths having a space gradually narrower toward a sheet withdrawal port, it would have been obvious to one skilled in the art at the time the invention was made as a matter of design choice to modify the two sheet guide paths having a space gradually narrower toward a sheet withdrawal port as a matter of design choice, supported by the Shimizu '811 reference since both of the designs have the same result for guiding the sheets toward withdrawal ports.

Applicants disagree. The Tajima '030 reference and the Shimizu '811 reference disclose two (2) sheet guides gradually narrower toward a sheet withdrawal port. However, the two sheet guides are the inner guides of the apparatus body 100, and are not a combination of a guide on the scanner apparatus and a guide on a base unit. Accordingly, both of the Tajima '030 reference and the Shimizu '811 reference do not suggest that the sheet withdrawal port is formed by the combination of the guide on the scanner apparatus and the guide on the base unit, and do not suggest that the two guides are made gradually narrower toward the sheet withdrawal port.

In addition to this, both of the Tajima '030 reference and the Shimizu '811 reference do not disclose an offset member.

On the other hand, the present invention of claim 24 has the sheet withdrawal port which is formed by the combination of the guide on the scanner apparatus and the guide on the base unit, and the two guides being made gradually narrower toward the sheet withdrawal port.

And, the present invention of claim 24 has the offset member.

Thus, the independent claim 24 has inventive step even when the Tajima '030 reference and the Shimizu '811 reference are considered.

Further, the dependent claims 25 and 50 depended from claim 24 also have the inventive step even when the Tajima '030 reference and the Shimizu '811 reference are considered.

Concerning claim 34, the Office takes the view that the Tajima '030 reference in view of the Shimizu '811 reference discloses the apparatus discussed in claim 24 above. Further, the Office reasons that the Tajima '030 reference further discloses that the base apparatus includes a first sheet guide provided at a location upstream of the second sheet transporting path and the scanner apparatus includes a second sheet guide provided at a location upstream of the second sheet transporting path.

Concerning claims 35-36, the Office takes the position that the Tajima '030 reference further discloses that the scanner apparatus includes a pick roller provided at a location upstream of the second sheet transporting path and viewed in a sheet transporting direction and includes a feed roller provided at locations downstream of the second sheet transporting path and the protecting member is provided at a location outside of a reading area of the scanner apparatus.

Concerning claim 47, the Office takes the position that the Tajima '030 reference discloses a sheet transporting direction of the sheet transporting path is substantially vertical, and the Shimizu '811 reference discloses the engaging portion and the scanner

mounting portion hold the scanner such that the scanner can rotate about a lower portion.

Applicants disagree with this postulation as well. First, as shown in the above description of claim 7, the second sheet transporting path (5) is not defined "by the scanner apparatus and the base apparatus" when the scanner is mounted" in the Tajima '030 reference, and also in the Shimizu '811 reference.

In addition to this, the Tajima '030 reference and the Shimizu '811 reference do not disclose that the first sheet guide and the second sheet guide are formed on the up stream of the second sheet guide.

On the other hand, as shown in the description of claim 7, the present invention of claim 34 has the second sheet transporting path which is defined "by a scanner apparatus and a base apparatus" "when the scanner is mounted" on the base apparatus.

And, the present invention of claim 34 has the first sheet guide and the second sheet guide both of which are formed on the up stream of the second sheet guide.

Thus, the independent claim 34 has inventive step even when the Tajima '030 reference and the Shimizu '811 reference are considered.

Further, the dependent claim 35 depended from claim 34 and claim 36 depended from claim 35 also have the inventive step even when the Tajima '030 reference and the Shimizu '811 reference are considered.

Claims 38-40, 42-45, 52-61 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the Shimizu '811 reference.

Concerning claim 38, the Office takes the position that the Shimizu '811 reference

discloses a multiple function apparatus comprising a base unit; a first transporting guide (100c); a first apparatus (printing unit 4 in the body) provide at a deflecting guide part and performing processing for the first sheet; a second transporting guide (200c), a second apparatus (scanning unit 5) for performing processing of the second sheet wherein the second apparatus is a removable mounted on the base unit and includes a reading element and being implemented as a hand scanner in a case where the scanner apparatus is detached from the base unit wherein a portion of the second transporting guide is movable so that the body including the first apparatus can be exposed.

The Office admits that the Shimizu '811 reference does not disclose that the first apparatus can be exposed when the hand scanner is detached from the base unit. However, since the part of the body including the printing unit 4 is exposed, the Office reasons that it would have been obvious to one skilled in the art at the time the invention was made to have the printing unit 4 exposed in the upper part or in the lower part of the body as a matter of design choice since the body of the first apparatus can be exposed either way.

Concerning claim 39-40, 42, 44, and 45, the Office postulates that the Shimizu '811 reference further discloses that the second apparatus is provided opposite of the first transporting guide, the directions of transport of the first sheet and second sheet form an angle smaller than 90 degrees; the second transporting guide is provided closer to the front side, the first apparatus is an image forming apparatus, the second apparatus is a scanner; a portion of the second transporting guide (the scanner) is movable; the first apparatus and second apparatus are provided to overlap each other.

Applicants agree that the Shimizu '811 reference discloses a first apparatus and a second apparatus. However, the first apparatus is not provided at the deflecting guide part of the first transporting guide, and the second apparatus is not provided at the second transporting guide along the first transporting guide.

In addition to this, the Shimizu '811 reference does not disclose that the first apparatus is exposed due to the moving of the second transporting guide along the deflecting guide part of the first transporting guide.

On the other hand, the present invention of claim 38 has the first apparatus which is provided at the deflecting guide part of the first transporting guide, and has the second apparatus which is provided at the second transporting guide along the first transporting guide.

And, the present invention of claim 38 has the first apparatus which is exposed due to the moving of the second transporting guide along the deflecting guide part of the first transporting guide.

Thus, the independent claim 38 has inventive step even when the Shimizu '811 reference is considered.

Further, the dependent claims 39, 40 and 45 depended from claim 38 and claims 42 – 44 also have the inventive step even when the Shimizu '811 reference is considered.

Concerning claim 43, the Office admits that the Shimizu '811 reference does not directly disclose a cover, which is a portion of the second transporting guide to cover the image forming apparatus. However, the Office reasons from Fig.3-4, the mounting portion

of the base has a vertical part as a portion of a transporting guide and as a part of a cover. It would have been obvious to one skilled in the art at the time the invention was made to consider the vertical straight part of the apparatus is a cover part of the image forming apparatus since it protect the parts inside the body of the apparatus.

Concerning claims 52, 59, the Office takes the position that the Shimizu '811 reference discloses an apparatus as discussed in claim 38 above. The Office admits that the Shimizu '811 reference does not directly disclose a cover which is a portion of the second transporting guide to cover the image forming apparatus. However, From Fig.3-4, the Office reasons that the mounting portion of the base has a vertical part as a portion of a transporting guide and as a part of a cover and concludes that it would have been obvious to one skilled in the art at the time the invention was made to consider the vertical straight part of the apparatus is a cover part of the image forming apparatus since it protect the parts inside the body of the apparatus.

It is Applicants' position that the Shimizu '811 reference discloses that the sheet transporting path of the scanner abuts on an image forming apparatus (FIG. 4). However, the Shimizu '811 reference does not disclose that the sheet guide of the scanner, which forms a part of the sheet transporting path, functions as the cover of the image forming apparatus.

On the other hand, the present invention of claim 59 has the sheet guide of the scanner which forms a part of the sheet transporting path and which functions as the cover of the image forming apparatus.

Thus, the independent claim 59 has inventive step even when the Shimizu '811 reference is considered.

Further, the dependent claim 60 depended from claim 59 also has the inventive step even when the Shimizu '811 reference is considered.

Concerning claims 53-54, the Office admits that the Shimizu '811 reference fails to disclose a cover that can be opened and closed or the cover can be removed. However, the Office takes the position that it is a matter of design choice to have such cover since a cover, which can be opened and closed or removed, is commonly used for cover any device and thus it would have been obvious to one skilled in the art at the time the invention was made as a matter of design choice to have a cover which can be opened and closed or the cover can be removed since the Shimizu '811 reference also discloses a cover 100c which can be open or closed or a cover (scanner) which can be removed.

Concerning claims 55-58, the Office takes the position that the Shimizu '811 reference further discloses that the base apparatus is an image forming apparatus, a sheet guide of the image forming apparatus and a sheet guide of the scanner apparatus are provided adjacent to each other, a sheet feeding portion of the scanner is provide frontward.

Applicants disagree. First, as shown in the description of claim 7, the sheet transporting path (5) is not defined by "the scanner apparatus and the base apparatus" when the scanner is mounted" in the Shimizu '811 reference.

In addition to this, the Shimizu '811 reference discloses the cover of the base apparatus, but it is not the cover that guides a sheet from the sheet transporting path.

On the other hand, as shown in the description of claim 7, the present invention of claim 7 has the second sheet transporting path which is defined by “a scanner apparatus and a base apparatus” “when the scanner is mounted” on the base apparatus.

And, the present invention of claim 52 has the cover of the base apparatus which guides a sheet from the sheet transporting path.

Thus, the independent claim 52 has inventive step even when the Shimizu ‘811 reference is considered.

Further, the dependent claims 53 - 58 depended from claim 52 also have the inventive step even when the Shimizu ‘811 reference is considered.

Claim 41 has been rejected under 35 U.S.C. §103(a) as being unpatentable over the Shimizu reference as applied to claim 38 above, and further in view of Tajima.

Concerning claim 41, the Office takes the position that the Shimizu ‘811 reference further discloses a first transporting mechanism transporting the first sheet from the straight guide part toward the deflecting guide part; a second transporting mechanism transporting the second sheet. The Office admits that the Shimizu ‘811 reference fails to disclose that the direction of the second sheet is in substantially a same direction as the first sheet. However, the Office postulates that it is a matter of design choice to have the first and second sheet transports having the same direction. According to the Office Action, the Tajima ‘811 reference discloses a system having a detachable scanner mounted on a base unit having tow transporting mechanism wherein the direction of the first and second sheets are in substantially the same direction. The Office concludes that it would have been



obvious to one skilled in the art at the time the invention was made as a matter of design choice to have the first and second sheet direction at the same direction as a matter of design choice supported by the Tajima '030 reference since both ways can transport the sheets to the withdrawing ports.

Applicants respectfully disagree. The Tajima '030 reference and the Shimizu '811 reference disclose first and second sheet delivery ports provided on the same side. However, the first apparatus is not provided at the deflecting guide part having a first sheet delivery port downstream, and the second apparatus is not provided at the second transporting guide having a second sheet delivery port downstream.

On the other hand, the present invention of claim 41 has the first apparatus which is provided at the deflecting guide part having a first sheet delivery port downstream, and has the second apparatus which is provided at the second transporting guide having a second sheet delivery port downstream.

Thus, the dependent claim 41 has inventive step even when the Tajima '030 reference and the Shimizu '811 reference are considered.

As the prior art as a whole fails to suggest the combination of features as claimed, Applicant respectfully requests that the Examiner favorably consider the claims in view of the discussion above. Applicant respectfully solicits allowance of this application.

It is applicant's position that all claims are now allowable. Should the Examiner determine that issues remain that have not been resolved by this response, the Examiner is requested to contact Applicant's representative at the number listed below.

Favorable action is requested.

Respectfully submitted  
for Applicant,



By: \_\_\_\_\_

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JJM/DWK:  
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